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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,025	08/04/2003	Michael A. Kamara	1171-202	5809

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EXAMINER

LAVINDER, JACK W

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 05/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/634,025

Applicant(s)

KAMARA ET AL.

Examiner

Jack W. Lavinder

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-16, 18 and 20-31 is/are pending in the application.
- 4a) Of the above claim(s) 28-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-16, 18 and 20-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Newly submitted claims 28-31 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 28-30 are directed to a medallion, which is a subcombination of the article of jewelry. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the medallion in the subcombination doesn't require a single channel. The subcombination has separate utility such as a medal for wearing on a shirt or a medal to be held in a pocket or on display in a framed housing.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 28-31 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

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F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 12-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7-13 of U.S. Patent No. 6601965. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the claims in the application encompass the scope of the claims in the patent, i.e., the claims in the application are broader in all respects and would, if patented, extend the monopoly rights of US Patent 6601965.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 12-16,18,20-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The scope of the medallion limitation cannot be determined. On the one hand, the claim recites a limitation directed to a medallion, which is considered to be a medal or jewelry element having a body. The claim then confuses the scope of the medallion

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limitation by reciting "said medallion consisting of a single aperture and a light emitting diode housed within said aperture." How or what is the medallion being claimed. How can a medallion only have an aperture and an LED? Doesn't the term medallion imply that there is a body, which forms the medallion?

For examination purposes, the limitation directed to the medallion will be assumed to include a body that has an aperture with an LED positioned in the aperture.

Also, the limitations that the clasp and medallion being located within a discontinuity is misdescriptive. Neither the clasp nor the medallion is within a discontinuity.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 12-15, 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Ohlund, 6626009.

Regarding claims 12 and 13, Ohlund discloses an article of jewelry (necklace, figure 1) comprising a flexible conductor (insulated wire 34, 36) having an exterior coating of non-conductive composition forming a loop, a clasp (48), a medallion (20) having a body (20, 32) with an aperture (26) and a light emitting diode (24) within the aperture.

Regarding claims 14 and 15, Ohlund discloses a light emitting diode (26) located the same radially distance from the outer exterior cylindrical surface of the body portion 32.

Regarding claim 23, Ohlund discloses a light emitting diode mounted on the inner cylindrical surface of the medallion. Therefore, the LED in Ohlund is viewed as a surface mounted light emitting diode.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 16, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamilton, 3968357 in view of Ohlund, '009.

Regarding claims 16 and 18, Hamilton discloses an earring having an insulated flexible conductor (26, 30) forming a loop with first and second discontinuities, wherein a clasp (36, 40) and a medallion (12) are located at the discontinuities, respectively. The medallion being made of a single piece, translucent ball (12) having an aperture (14, figure 3) with an incandescent lamp located within the aperture.

Hamilton fails to disclose a light emitting diode within the aperture. Ohlund discloses that either an incandescent lamp or a light emitting diode can be used to illuminate the medallion (col. 2, lines 45-53).

It would have been an obvious design choice to use a light emitting diode in place of Hamilton's incandescent lamp since Ohlund teaches that these light sources are design equivalents in that they both emit light equally as well as the other.

7. Claims 16, 18, 20, 22, 24, 25, 26, 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohlund in view of Hamilton.

Regarding claims 16, 18, 20, 22, 26, 27, Ohlund is applied as set forth above. Ohlund also discloses an aperture for receiving the conductor (at 42) and a battery (82) in communication with the clasp. Ohlund fails to disclose a medallion being made from a single piece of translucent material. Hamilton discloses the use of a medallion being made from a single piece of translucent material (12) with the light emitting source located within the aperture in the medallion. It would have been obvious to a person having ordinary skill in the art to have made Ohlund's medallion from a single piece of translucent material as taught by Hamilton in order to produce a more aesthetically pleasing medallion necklace.

Regarding claim 24, 25, Ohlund discloses a light emitting diode mounted on the inner cylindrical surface of the medallion. Therefore, the LED in Ohlund is viewed as a surface mounted light emitting diode.

8. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohlund in view of Hamilton, as applied above, and further in view of Murphy, 4262324.

Ohlund in view of Hamilton fail to disclose a clasp having electrical contacts larger than the cross sectional area of the aperture receiving the conductor. Murphy

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discloses an electrical contact in a clasp having a surface area greater than the cross sectional area of an aperture receiving a conductor.

It would have been obvious to a person having ordinary skill in the art to have enlarged Ohland's electrical contact surface area in order to ensure a better electrical connection between the conductor and the battery.

Response to Arguments

9. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

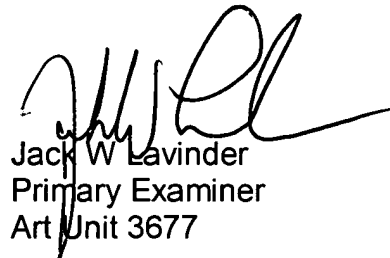
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack W. Lavinder whose telephone number is 571-272-7119. The examiner can normally be reached on Mon-Friday, 9-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jack W. Lavinder
Primary Examiner
Art Unit 3677

5/11/05